

Serial No. 09/877,372
Docket No. H 4858

REMARKS

Claims 1-7 were pending in the application. Claims 1-4 stand withdrawn from consideration pending the outcome of the restriction requirement. Claims 8 and 9 have been added and depend from claim 5. Thus the claims under consideration are claims 5-9.

Claim 5 has been amended to clarify that the pressure element deforms in the claimed process to match the face of the substrate and to exert uniform pressure thereon. This is described at page 6, lines 7-13 of the application. The subject matter of claims 8 and 9 is found at page 6, lines 25-27. No new matter has been added.

Restriction/Election

Restriction under 35 U.S.C. § 121 has been made between claims 1-4 (group I) and claims 5-7 (group II). Applicants provisionally elected group II for prosecution, with traverse. The restriction should be withdrawn for the following reasons.

While applicants do not dispute the examiner's allegations that the two groups of claims are independent or distinct, it has not been shown that a search and examination of the claims together would be seriously burdensome. M.P.E.P. § 803. The claim elements of groups I and II essentially coincide, and it is these limitations that primarily establish the scope of relevant art that needs to be searched. Thus, searching both groups will not present a serious burden, and application of the results to each group of claims will be substantially similar. For this reason applicants respectfully ask that the restriction requirement be withdrawn, and that all claims be examined on the merits together.

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Claim Rejections - 35 U.S.C. § 102

Claim 5 has been rejected as anticipated by Finke U.S. 4,261,783. As amended, claim 5 should not be found anticipated over this reference. The method of claim 5 requires an elastically deformable pressure face that deformably matches and exerts uniform pressure on the shape of the narrow face or of the profile bar. This element differs considerably from the applicator disclosed in Finke.

The roll applicator of Finke comprises spaced apart, parallel, flexible, resilient annular discs or disc portions. Each disc is provided at its periphery with small projections that "provide only a small area of contact between the applicator 201 and the label 21H." Finke at column 5, lines 15-21. While the discs of Finke's device do deform, they are incapable of exerting a uniform pressure on the label because of the spaces between the discs and small projections. Where there is no contact, there is no pressure exerted, and therefore there is no uniform pressure exerted. See Finke, Figures 8-10. Indeed, exerting such pressure would be contrary to the presence of the small projections used to reduce the contact area between Finke's applicator and the label. Thus the claimed pressure face is neither taught nor suggested by Finke.

The secondary references do not supply the teachings of the invention not found in Finke. Combination of Paulk U.S. 6,529,799 with Finke is questionable initially since Paulk discloses a method of affixing labels to wood by stapling, not adhesives. See Paulk column 5, line 64-65 and column 7, lines 62-67. More importantly, Paulk does not disclose or suggest the claimed pressure face that deformably matches and exerts uniform pressure on the shape of the substrate. Shut U.S. 6,376,058 is equally deficient in this regard. Thus there is no combination

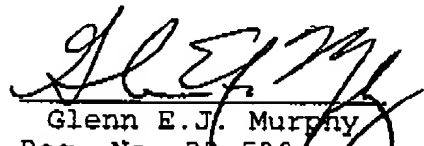
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of the references of record that can be used to reject claim 5-9
as amended herein.

CONCLUSION

Applicants respectfully request reconsideration and allowance of the claims in view of the amendments and remarks above. Should any fees be due for entry and consideration of this Amendment that have not been accounted for, the Commissioner is authorized to charge them to Deposit Account No. 01-1250.

Respectfully yours,


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